

PATENT

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1-2-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:	Kuslich et al.
Application No.:	09/738,726
Filed:	December 15, 2000
For:	TOOL TO DIRECT BONE REPLACEMENT MATERIAL
Examiner:	Nihir Patel
Group Art Unit:	3743

FAX RECEIVED
DEC 30 2002
GROUP 3700Box Non-Fee Amendment
Assistant Commissioner for Patents
Washington, D.C. 20231

Docket No: S85.2-7189-US02

RESPONSE

This Response is in response to the Office Action mailed October 1, 2002, wherein the election of species was acknowledged, and claims 1-6 were rejected under 35 U.S.C. §103(a) as being obvious in light of U.S. 5,577,517 to Bonutti.

The specific rejections to the claims are addressed in the following paragraphs, which have headings and paragraph numbers corresponding to the order the rejections were presented in the Office Action.

Election/Restriction

In the Office Action dated October 1, 2002, the Examiner acknowledged Applicants' provisional election with traverse of the species corresponding to FIGs. 1-4. Applicants affirm the election of the species corresponding to FIGs. 1-4.

Response to Amendment

1. It is noted that the Office Action acknowledges the persuasiveness of Applicants' traversal of the species requirement on the grounds that all of the claims are broad enough to cover all three species.

Application No.: 09/738,726
December 30, 2002

Response
Page 2

Claim Rejections – 35 USC § 103

2. In the Office Action claims 1-6 were rejected under §103 as being obvious in light of Bonutti. The Office Action states that Bonutti discloses Applicants' invention as claimed with the exception of stating at least one deflector opening has a length of about $1 \frac{1}{2}$ to 3 D, wherein D is the internal diameter of the tube.

In response, Applicants respectfully note that Bonutti fails to teach or suggest all of the elements of the stated claims as Bonutti not only fails to teach or suggest solving the problems to which the device described in the instant claims is directed to solve, but Bonutti also fails to teach or suggest the source of the problem to which the instant Application is directed.

The Federal Circuit recognizes numerous tenants of patent law that must be adhered to when applying §103 (see generally *Hodosh v. Block Drug Co.*, 786 F.2d 1136, 229 USPQ 182, 187 (Fed. Cir. 1986)). For example, it is recognized that in order to establish a §103 obviousness rejection the reference or references must be considered as a whole and suggest the desirability and thus the obviousness of making the combination (*Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481 488 (Fed. Cir. 1984)). It is further recognized that the cited reference or references must be viewed without the benefit of hindsight vision afforded by the claimed invention (*W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)). It is also recognized that a §103 obviousness rejection cannot be established if when combining multiple references or modifying a single reference, the reference or references fail to teach the source of the problem and the recognition of the source of the problem is what is unobvious (*Eibel Process Co. V. Minnesot and Onterio Paper Co.*, 261 US 45 (1923); *In re Sponnoble*, 405 F.2d 578, 160 USPQ 237 (CCPA 1980)).

In the instant claims a tool for directing bone graft *into* a space is claimed. The tool claimed requires that the at least one deflector opening *deflects bone material out of the tube* at an angle relative to the longitudinal axis of the tube. As is extensively described in the specification of the present Application, the presence of the at least one deflector is to provide the

Application No.: 09/738,726
December 30, 2002

Response
Page 3

tool with the ability to pass fill material through the tube and be deflected into a space so that the internal forces created by filling the space do not result in ejection the tool from the space along its longitudinal axis. The use of a deflector allows forces within the space to be exerted back to the sides of the tool thereby preventing ejection of the tool when fill material is passed through the tube and deflected into the space (page 3, line 29 – page 4, line 4).

In stark contrast with the instant claims, Bonutti describes a tissue *removal* apparatus, which has a cutting tip specifically designed to provide proper cutting and suctioning capabilities when cutting and *removing* tissue (see generally the Abstract as well as column 7, lines 55-65). Nothing in the Bonutti reference teaches or suggests a tool for directing bone graft *into* a space or to supply such a tool with at least one deflector opening *deflects bone material out of the tube* at an angle relative to the longitudinal axis of the tube as the instant claims require.

Bonutti clearly state that the invention described therein is a percutaneous tissue removal apparatus (column 1, lines 54-56). As a removal apparatus, there can be no motivation to provide Bonutti with a deflector for deflecting material *out of the tube*, given that such a deflector has a function that is expressly contrary to the stated function of the Bonutti apparatus. Because the present Application seeks to address a problem that Bonutti not only fails to recognize, but is contrary to the stated function of the Apparatus that Bonutti does describe, it is clear that one of ordinary skill will find no motivation to modify Bonutti to include the deflector described in the instant claims.

In light of the above, it must therefore be concluded that it is only when Bonutti is viewed through the impermissible lens of hind sight provided by the instant Application does the motivation to modify Bonutti become clear. Attempting to establish an obviousness type rejection based on such hind sight interpretation is improper. As a result, the rejection is respectfully traversed.

Application No.: 09/738,726
December 30, 2002

Response
Page 4

FORMALITIES

If an extension of time is required to make this response timely and no separate petition is enclosed, Applicants hereby petition for an extension of time sufficient to make the response timely. In the event that this response requires the payment of government fees and payment is not enclosed, please charge Deposit Account No. 22-0350.

CONCLUSION

In view of the foregoing it is believed that the present application, with claims 1-6 is in condition for allowance. Early action to that effect is earnestly solicited.

Respectfully submitted,
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Date: 12/24/02

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